

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated February 17, 2006 (hereinafter Office Action) have been considered. Claims 1-48 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant acknowledges withdrawal of the objection to the Abstract and rejections under 35 U.S.C. §112, second paragraph presented in the first Office Action.

Claims 1-3, 5-7, 9, 10, 12, 13, 16, 25, 30, 32, 35, 37-39 and 44 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,867,163 to *Schaldach* (hereinafter "*Schaldach*"). Claims 17, 19-21, 41, 45 and 46 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over *Schaldach*. Claims 4 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Schaldach* in view of U.S. Patent No. 6,477,406 to *Turcott* (hereinafter "*Turcott*"). Claims 8, 11 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Schaldach* in view of U.S. Patent No. 5,935,081 to *Kadhiresan* (hereinafter "*Kadhiresan*"). Claims 14, 18, 22-24, 31, 33, 34, 43 and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Schaldach* in view of U.S. Patent No. 5,321,618 to *Gessman* (hereinafter "*Gessman*"). Claims 15, 26-29, 42 and 48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Schaldach* in view of U.S. Publication No. 2002/0026223 to *Riff* (hereinafter "*Riff*").

Applicant has carefully considered the Examiner's Response to Arguments presented in the Office Action. Notwithstanding the discussion concerning the meaning of the term "audio," the Examiner has not identified where in *Schaldach* each and every feature of Applicant's independent claims 1, 17, 32, and 44 is disclosed, either expressly or inherently.

In addition to other features, each of Applicant's independent claims 1, 17, 32, and 44 recites communicating both a cardiac electrical signal and an audio signal representative of a cardiac non-electrophysiologic activity (e.g., heart movement) to a patient-external

location. Although the Examiner argues that *Schaldach* teaches production of an audio signal by measured value pickups 117-120, the Examiner has not identified where in *Schaldach* there is a teaching or suggestion of telemetering such an “audio signal” to a patient-external location, along with a cardiac electrical signal. Applicant argued the absence of this feature in the prior responsive communication, which required the Examiner to particularly point out where this teaching in *Schaldach* is purportedly found. The Examiner has not provided such identification in the final Office Action.

Applicant’s careful review of *Schaldach* reveals no teaching or suggestion in *Schaldach* that any audio signal or other signal containing audio signal information is telemetered to a patient-external device along with a cardiac electrical signal. The reason for this absence of teaching appears clear, given the use of the signals derived from the measured value pickups 117-120 in *Schaldach*. As was strenuously argued in Applicant’s prior responsive communication, the signals derived from the measured value pickups 117-120 are used to control pacing, including pacing rate. In particular, *Schaldach*, at column 20, lines 67-68, describes that the pressure or sound pickups measure stroke volume which is used in controlling pacing, including pacing rate.

Any audio signals derived from the measured value pickups 117-120 are used to control pacing, and are not described as being of interest beyond the context of pacing control. There is simply no teaching or suggestion by *Schaldach* that an audio signal is communicated outside the body by the disclosed device. *Schaldach* only teaches that a microphone may be used to derive measured values such as stroke volume, but does not teach that an audio signal of the type contemplated in Applicant’s claims is produced from the microphone, or that any such audio signal is stored and/or communicated to a patient-external device.

Respectfully, the rejection of independent claims 1, 17, 32, and 44 under 35 U.S.C. §102(b) is not sustainable, as the Examiner has not established *prima facie* anticipation of each and every element recited in these claims. The disclosure in an anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue

experimentation. *Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003). See, also, MPEP § 2121.01.

Applicant respectfully asserts that *Schaldach*'s description of a rate-adaptive pacemaker that uses sound pickups to derive measured value pickup signals for the stated purpose of controlling pacing or pacing rate is insufficient to support the Examiner's anticipation rejection of Applicant's claims 1, 17, 32, and 44. It is unclear how one skilled in the art could arrive at Applicant's claimed structure and functionality using *Schaldach*'s rate-adaptive pacemaker teachings without undue experimentation, particularly in the clear absence of a teaching regarding telemetering of an audio signal or other signal containing audio signal information to a patient-external device along with a cardiac electrical signal.

Concerning the Examiner's comments regarding claims 2 and 35 on page 3 of the Office Action, Applicant maintains its prior position that the accelerometer signal disclosed in *Schaldach* is used to detect patient activity. There is no teaching in *Schaldach* that the accelerometer signals in *Schaldach* that indicate patient motion are of sufficient frequency to constitute audible signals perceivable by the human ear. The Examiner's contention that the acceleration signals generated by patient movement in *Schaldach* meet Applicant's recitation of audio signals produced by the accelerometer recited in claims 2 and 35 is unsupported speculation. Applicant respectfully requests the Examiner to produce a reference that supports this purported factual assertion.

With regard to the Examiner's comments regarding claims 17, 30, and 38 on pages 3 and 4 of the Office Action, Applicant refers the Examiner to the previously made remarks of the prior responsive communication and the remarks presented hereinabove.

Schaldach does not teach or suggest all of the claim limitations of Applicant's independent claims 1, 17, 32, and 44, therefore, these claims are not anticipated by *Schaldach*. Dependent claims 2, 3, 5-7, 9, 10, 12, 16, 19-21, 35, and 37-39, which are dependent from independent claims 1, 17, 32 or 44, respectively, were also rejected under 35 U.S.C. §102(b) as being anticipated by *Schaldach*. Applicant does not acquiesce with the particular rejections to any of these dependent claims, but believes these rejections are

moot in view of the comments provided above. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 2, 3, 5-7, 9, 10, 12, 16, 19-21, 35, and 37-39 are also patentable over *Schaldach*. Applicant reserves the right to further address the rejections of these dependent claims if the rejections are maintained.

Concerning the various rejections of dependent claims under 35 U.S.C. §103(a) summarized above, each of these dependent claims depends from independent claim 1, 17, 32, or 44. For the reasons set forth above, independent claims 1, 17, 32, and 44 are not anticipated or rendered obvious in view of *Schaldach*. For example, and as discussed above, the asserted references fail to teach or suggest all limitations of Applicant's independent claims. While Applicant does not acquiesce with any particular rejections to these dependent claims, these dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

It is to be understood that Applicant does not acquiesce to Examiner's characterization of the asserted art or Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to Applicant's claimed subject matter. Moreover, Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, alternative equivalent arrangements, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above or in the prior responsive communication is not necessary, in view of the clear absence of teaching and suggestion of various features recited in Applicant's pending claims and lack of motivation to combine reference

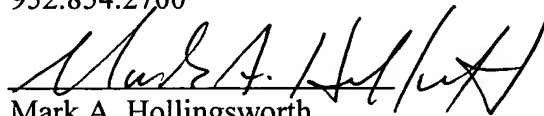
teachings. Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Applicant respectfully requests that finality of the instant Office Action be withdrawn in view of the clear lack of evidentiary showing required to sustain findings of anticipation and obviousness of Applicant's claimed subject matter. It is believed that claims 1-48 are directed to allowable subject matter, timely notification of which is respectfully solicited. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if there are any questions regarding Applicant's responsive communication or if prosecution of this application may be assisted thereby. Authorization is given to charge Deposit Account No. 50-3581 (GUID.609PA) any necessary fees for this filing.

Respectfully submitted,
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By:



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